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OFFICE OF PETITIONS

In re Patent No. 5,920,338 :
Issued: July 6, 1999 :
Application No. 08/964,305 : **ON PETITION**
Filed: November 4, 1997 :
Attorney Docket No. A10:01462 :

This is a decision on the "PETITION UNDER 37 C.F.R. § 1.182 FOR DECISION ON A QUESTION NOT SPECIFICALLY PROVIDED FOR TO WITHDRAW INCORRECT TERMINAL DISCLAIMER" filed January 29, 2010.

The petition is **DISMISSED** to the extent that the Terminal Disclaimer filed November 18, 1998 will not be removed from the record.

A review of the record indicates that a terminal disclaimer was filed under 35 U.S.C. § 253 and 37 CFR 1.321(c) on November 18, 1998. The terminal disclaimer was relied upon by petitioner to overcome a rejection on the grounds of obviousness-type double patenting involving the claims of co-pending application no. 08/963,992. Petitioner argues that due to a typographical error, the Terminal Disclaimer filed November 18, 1998 and in response thereof the Notice of Allowability incorrectly identified U.S. Patent 5,216,502, which has an application serial number of 07/629,255 to overcome a double patenting rejection and that therefore, the November 18, 1998 Terminal Disclaimer should be withdrawn or in the alternative, the correction of the terminal disclaimer to correctly identify and disclaim the term based on US Patent Application No. 08/963,992 (as identified by the May 15, 1996 Office action) instead of U.S. Patent No. 5,216,502.

The Terminal Disclaimer filed November 18, 1998 was executed by was executed by Barry Katz. In the disclaimer, Barry Katz is identified as an owner and an inventor, and disclaimed that "...the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of Patent No. 5,216,502....."

While the Terminal Disclaimer filed November 18, 1998 was accepted and recorded by the examiner, and while it was noted on the face of the patent that "this patent is subject to a terminal disclaimer", no application number is recited (i.e., the term of this patent that extends beyond the expiration date of application no.). Neither the terminal disclaimer nor the alleged ambiguity actually exists on the patent. Thus, there is no error in the patent requiring correction. As such, this petition does not necessitate consideration of whether issuance of a certificate of correction is warranted.

Rather, Patentees request that the Terminal Disclaimer filed November 18, 1998 be withdrawn and or corrected.

The Terminal Disclaimer filed November 18, 1998 was made of record and despite the typographical error in the terminal disclaimer, the examiner properly considered the terminal disclaimer to disclaim the terminal part of any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term of patent 5,216,502, which has an application serial number of 07/629,255, not 08/963,992, in examination and allowance of this application.

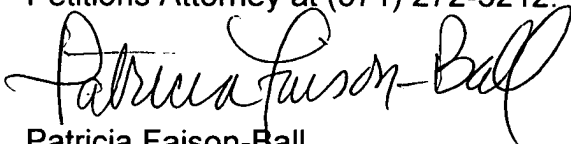
Nonetheless, removal of the Terminal Disclaimer filed November 18, 1998 from the application record is inappropriate. At the outset, unfortunately, once a patent issues, the USPTO will not remove the effect of a recorded terminal disclaimer in an issued patent. See Manual of Patent Examining Procedure (MPEP) § 1490(B); Bayer AG v. Carlsbad Technology Inc., 64 USPQ2d 1045, 1048-49 (Fed. Cir. 2002).

What is here controlling is that petitioner seeks to correct an issued patent. The statutory authority for amendment or correction of an issued patent is found in title 35, chapter 25. The instant petition does not involve correction of a mistake by the Patent and Trademark Office (Office) (35 USC § 254) or correction of the named inventor (35 USC § 256). In addition, while the instant petition involves a disclaimer, 35 USC § 253 merely authorizes the filing and recording of disclaimers; it does not authorize the withdrawal of a terminal disclaimer. Bayer, supra.

Unless a "mistake" is provided for in 37 CFR 1.322, 1.323, or 1.324, or affords legal grounds for reissue or for reexamination, such "mistake" will not be corrected subsequent to the issuance of an application as a patent. See 37 CFR 1.325: MPEP 1490. As further noted in MPEP 1490, the mechanisms to correct a patent (i.e., certificate of correction (35 USC § 255), reissue (35 USC § 251) and reexamination (35 USC § 305) are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer.

In accordance with the above reasoning, the Terminal Disclaimer will not be withdrawn and no further action will be undertaken. If petitioner would like the USPTO to consider a new terminal disclaimer, petitioner will have to consider filing a reissue application.

Telephone inquiries concerning this matter should be directed to the undersigned Petitions Attorney at (571) 272-3212.



Patricia Faison-Ball
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